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United States Court of Appeals for the Federal Circuit

98-1157

WILLIAM BRADSHAW and ROBERT SHEPHERD,
Plaintiffs-Appellants,

v.

IGLOO PRODUCTS CORPORATION,
Defendant-Appellee.

DECIDED: September 18, 1998

Before RICH, MICHEL, AND CLEVENGER, Circuit Judges.

MICHEL, Circuit Judge.

William Bradshaw and Robert Shepherd (hereinafter "Bradshaw") filed this appeal after the United States District Court for the Northern District of Illinois granted summary judgment in favor of Igloo Products Corporation ("Igloo"), concluding that, as a matter of law, Igloo's "Cool Roller," a portable drinks cooler, did not infringe Bradshaw's patent, United States Patent No. 4,873,841 (the "'841, patent") under the doctrine of

equivalents. See Bradshaw v. Igloo Prods. Corp., No. 94-C-6497 (Memorandum Opinion and Order Aug. 28, 1997). Although it incompletely applied our remand directions in Bradshaw v. Igloo Products Corp., 101 F.3d 716, 1996 WL 663310 (Fed. Cir. 1996) (Table), we conclude the district court nonetheless reached the legally correct result. Therefore, the district court's summary judgment of no equivalent infringement is affirmed.

BACKGROUND

On April 3, 1989, Bradshaw filed a patent application disclosing his portable drinks cooler on wheels. The application issued as the '841 patent on October 17, 1989, with three independent and twelve dependent claims. The first independent claim, claim 1, claims the basic cooler. Claims 6 and 11 each claim variations of this portable cooler, with different wheel-and-axle mounting configurations and the further requirement that one of the pair of lifting handles be located on the same side of the cooler as the wheels.

Bradshaw attempted to license the invention of the '841 patent to Igloo, one of the largest manufacturers of drinks coolers in the United States, but after several discussions Igloo decided not to enter a licensing agreement Bradshaw. Igloo later built a prototype of a new portable cooler, and commercially sold two coolers that, like the cooler claimed in Bradshaw's patent, included wheels and a pulling handle. These two cooler products were called the "Cool Roller," at issue in this appeal, and the "Rolling Kool Locker." Bradshaw filed suit in district court on October 28, 1994, alleging that Igloo's prototype and products infringed the '841 patent literally or under the doctrine of equivalents. Igloo's answer and counterclaim alleged, inter alia, that the '841

patent was invalid, but the district court issued no decision with respect to the patent's validity and thus that aspect of the case is not relevant to the appeal. Bradshaw also alleged that Igloo had infringed its trademark and violated Illinois trade practice law, but these allegations are not at issue in this appeal, and will not be discussed further.

Igloo filed a motion for summary judgment of no infringement. The district court, after concluding there was no genuine dispute of material fact precluding summary judgment, construed the three independent claims of the '841 patent to require two separate and distinct handles on the side of the cooler opposite the wheels -- one for pulling and one for lifting -- attached to the same handle support axle. See Bradshaw v. Igloo Products Corp., 912 F.Supp. 1088, 1098 (N.D. Ill. 1996). The court noted that this construction was supported by the drawings, which show two distinct handles attached to the same axle, and the written description. See id. Noting that the Rolling Kool Locker had only one handle on the side opposite the wheels which was used for both lifting and pulling, and that the Cool Roller used two separate axle attachments for the lifting and pulling handles on the side opposite the wheels, the district court concluded that Igloo's products did not literally infringe the '841 patent. See id. The court also concluded that the prototype cooler built by Igloo, which did make use of a separate lifting and pulling handle attached to a single axle, did not infringe the '841 patent because Igloo did not use, sell, or make for sale the prototype in violation of 35 U.S.C. § 271(a)(1994). See id. at 1101.

Bradshaw appealed the district court's summary judgment. This court affirmed the district court's decisions of no literal infringement and no infringement by the prototype. See Bradshaw, 1996 WL at **2-**3.

In reaching this decision, we affirmed the district court's claim construction, noting that:

> The patent consistently speaks of the lifting handles and the pulling handle as distinct elements. The claims so indicate..., the specification so indicates..., and the drawings so indicate. There is absolutely no suggestion anywhere in the patent that the claims refer to anything less than a total of three separate handles. Likewise, the patent is equally clear that the lifting handle and the pulling handle on the side of the cooler opposite the wheels are both coupled to the same attachment axle.

Id. at **2. This court vacated the ruling of noninfringement under the doctrine of equivalents, however, because of two legal errors committed by the district court: first, according to the panel, the court "erred when it considered only whether selected limitations of the claims were disclosed in the prior art and failed to consider the patented invention as a whole," when several of the other limitations in the claims might nonetheless have sufficed to confer patentability in light of the prior art; and second, the court failed to consider equivalency with respect to each of the two accused products, "thereby failing to consider that the scope of patent protection would have to be expanded beyond that afforded by the claims in two separate respects." Id. at **4. We therefore remanded the case to the district court with direction to reconsider potential infringement under the doctrine of equivalents, and specifically for a complete analysis under Wilson Sporting Goods Co. v. David Geoffrey & Assocs., 904 F.2d 677, 14 USPQ2d 1942 (Fed. Cir. 1990).

On remand, Igloo again moved for summary judgment of no infringement under the doctrine of equivalents. Bradshaw moved to strike the motion and requested other sanctions against Igloo based on alleged discovery violations. The court dismissed Bradshaw's motion, and that decision is not on appeal here. The district court then reconsidered whether the Cool Roller and the Rolling Kool Locker infringed the '841 patent under the doctrine of equivalents. In accordance with Wilson Sporting Goods, the district court drafted a hypothetical claim by easing certain limitations, thus creating a hypothetical claim broad enough to cover the Cool Roller. See Bradshaw, slip op. at 10-11, 13-14. The court then concluded that the prior art, specifically United States Patent No. 4,846,493 (the "Mason patent"), made this hypothetical claim unpatentable because the redrafted elements -- namely, a pulling and a lifting handle attached to the same side of the cooler but to separate and distinct handle support structures -- were specifically disclosed therein. See id. It concluded, therefore, that "[t]he prior art of the Mason patent prohibits [Bradshaw] from showing that the Cool Roller infringes the '841 patent under the doctrine of equivalents." Id. at 14. Thus, the district court granted Igloo's motion for summary judgment as to the Cool Roller. See id. at 17. With respect to the Rolling Kool Locker, however, the district court concluded there was a genuine factual dispute regarding whether two separate handles are equivalent to one handle used for both pulling and lifting, and thus denied summary judgment respecting that product. See id. at 16-17.

After the district court issued its decision, Bradshaw filed a motion to dismiss voluntarily its infringement claim as to the Rolling Kool Locker. The district court granted the motion, and entered judgment

regarding the Cool Roller. See Bradshaw v. Igloo Prods. Corp., No 94-C-6497 (Order Dec. 2, 1997). Bradshaw then appealed from the summary judgment of noninfringement with respect to the Cool Roller, arguing that the district court misapplied the law of Wilson Sporting Goods in determining that the '841 patent was not entitled to a scope of equivalents that include the Cool Roller, and that if the district court had properly applied the Wilson Sporting Goods test, material facts were sufficiently in dispute regarding the equivalency of the relevant features of the accused device such that summary judgment was improper. We have jurisdiction to consider this appeal under 28 U.S.C. § 1295(a)(1) (1994). Oral argument was heard on August 7, 1998.

DISCUSSION

The doctrine of equivalents allows a patentee to exercise the right to exclude devices that do not literally meet the limitations of the claims of the patent but differ only insubstantially from the claimed invention, for example, because they have substantially the same function, way, and result. See Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1533, 3 USPQ2d 1321, 1325 (Fed. Cir. 1987) ("To be a 'substantial equivalent,' the element substituted in the accused device for the element set forth in the claim must not be such as would substantially change the way in which the function of the claimed invention is performed."); see also Graver Tank & Mfg. Co. v Linde Air Prods. Co., 339 U.S. 605, 608 (1950) (holding that an insubstantial change is shown if a patentee demonstrates that the accused product performs substantially the same function in substantially the same way to produce substantially the same result as the patented invention).

Although what constitutes infringement under the doctrine of equivalents is a question of fact, often amenable to a jury trial, see, e.g., Perkin-Elmer, 822 F.2d at 1531, 3 USPQ2d at 1323 ("[i]n sum, a determination of nonequivalence is a finding of fact"), there are several limits on the range of equivalents legally available. For example, an accused device cannot equivalently infringe a patent claim unless every limitation, or its equivalent, is found in that device; this is known as the "all elements" or "all limitations" rule. See Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, ---, 117 S. Ct. 1040, 1054 (1997) (noting that the essential inquiry under the doctrine of equivalents is "[d]oes the accused product or process contain elements identical or equivalent to each claimed element of the patented invention," and holding that "[t]he determination of equivalence should be applied as an objective inquiry on an element-by-element basis"); Ethicon Endo-Surgery Inc. v. United States Surgical Corp., --- F.3d ---, ---, --- n.*, 47 USPQ2d 1272, 1276, 1277 n.* (Fed. Cir. 1998); Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 935, 4 USPQ2d 1737, 1740 (Fed. Cir. 1987) (in banc). Similarly, a patentee may not rely on the doctrine of equivalents to obtain protection against infringement by subject matter that it could not have patented; the scope of protection available under the doctrine of equivalents is thus limited by the prior art. See Wilson Sporting Goods, 904 F.2d at 684. Where an accused device cannot infringe under the doctrine of equivalents because of the application of one of these legal bars, summary judgment of non-infringement is appropriate.

I.

Bradshaw's strongest argument on appeal is that, despite our remand order, the district court still failed to apply correctly Wilson Sporting Goods to the hypothetical claim which the court drafted to cover the Cool Roller. As we explained in Wilson Sporting Goods:

> Whether prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer. To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a hypothetical patent claim, sufficient in scope to literally cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents.

904 F.2d at 684, 14 USPQ2d at 1948 (final emphasis added). As we have clarified in several subsequent cases, including our remand decision in this case, a district court must consider the hypothetical claim not by focusing on its individual elements but as a whole to determine whether the device, if so claimed, would have been obvious over the prior art. See Bradshaw, 1996 WL at **4 ("While the location of the handles is the only element involved in the present dispute regarding infringement by equivalents, it is not the only limitation within the asserted claims....It is conceivable that any one of these limitations, alone or in combination with the other limitations, may have been sufficient to confer

patentability, and the district court erred when it failed to address this possibility in its analysis.").

The district court here failed to consider the hypothetical claim as a whole, but focused instead only on the two handles mounted proximately but on separate axles on the same side of the Cool Roller and the disclosure of exactly such structures in the Mason patent. Finding this disclosure in the prior art, the district court concluded that the legally available range of equivalents could not encompass the accused device because this necessarily broader claim limitation would itself have been obvious in light of the Mason patent.

Although we could remand this case once again to the district court with even more precise instructions regarding the application of the hypothetical claim test, this would not be an economic use of judicial resources, guarantee a final result for the parties who have been involved in this litigation for several years at great expense, or even avoid future additional appeals to this court.

II.

We are convinced that, despite its erroneous analysis, the district court here did reach the correct result, for the doctrine of equivalents may not legally cover the accused Cool Roller device. We are not bound to the analytical framework relied on by the district court, and are free to review the district court's decision applying an alternative rule of law. See Koyo Seiko Co. v. United States, 95 F.3d 1094, 1099 (Fed. Cir. 1996) (quoting SEC v. Chenery Corp., 381 U.S. 80 (1943)); Filmtec Corp. v. Hydranautics, 67 F.3d 931, 937, 36 USPQ2d 1410, 1413 (Fed. Cir. 1995).

As we held in Bradshaw's previous appeal to this court, the patent is extremely clear that the pulling handle and the nearby lifting handle are both attached to the same axle. See Bradshaw, 1996 WL at **2. Specifically, our examination of claim 1 of the '841 patent reveals that Bradshaw disclosed a "pulling handle coupled to one of the handle support axles." There can be no doubt, then, that the pulling handle and one lifting handle must be attached to the same handle support axle. The language of claims 6 and 11 is equally precise. Moreover, the specification makes repeated reference to the fact that the pulling handle is attached to the same handle support axle as one of the lifting handles. See, e.g., '841 pat., col. 1, ll. 31032; col. 2, ll. 63-64; col. 3, ll. 1-3. Thus, one element of the '841 patent must be a handle support axle to which both a lifting handle and a pulling handle are attached. That element or limitation is entirely missing in the accused cooler and thus equivalent infringement fails under Pennwalt's all-elements or all-limitations rule. See Pennwalt, 833 F.2d at 935, 4 USPQ2d at 1740.

AFFIRMED.

United States Court of Appeals for the Federal Circuit

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on November 4, 1998.

FOR THE COURT,

/s./ Jan Horbaly

Jan Horbaly
Clerk

Dated: October 28, 1998

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

OCT 28 1998

JAN HORBALY
CLERK

cc: JEFFREY W. BREND
RICHARD G. LIONE

BRADSHAW V IGLOO PRODUCTS, 98-1157
(DCT - 94-CV-6497)

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* Note: Pursuant to Fed. Cir. R. *
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